

## REMARKS

In the Office Action, the Examiner rejected Claims 1-45, which were all of the then pending claims, under 35 U.S.C. 103 as being unpatentable over the prior art, principally U.S. Patent 6,073,138 (de l'Etraz, et al.) and U.S. patent application publication no. 2002/0095298 (Ewing). In particular, Claims 1-5, 10-20, 25-34 and 40-45 were rejected as being unpatentable over de l'Etraz, et al. in view of Ewing; and Claims 6-9, 21-24 and 36-39 were rejected as being unpatentable over de l'Etraz, et al. in view of Ewing and further in view of U.S. Patent 6,014,634 (Scroggie, et al.). Claims 16-45 were further rejected under 35 U.S.C. 101 as directed to non-statutory subject matter.

Independent Claim 1 is being amended to better define the subject matter of the claim, and Claim 2 is being amended to describe in more detail a preferred feature of the invention.

Also, Applicants are canceling Claims 16-45 from further consideration in this application. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Examiner or that the claims are drawn to non-statutory subject matter, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of this application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

In view of the cancellation of Claims 16-45, it is believed that it is not necessary to discuss these claims further in this Amendment.

For the reasons set forth below, Claims 1-15 patentably distinguish over the prior art and are allowable. The Examiner is, hence, respectfully asked to reconsider and to withdraw the rejections of these claims under 35 U.S.C. 103, and to allow Claims 1-15.

Generally, Claims 1-15 patentably distinguish over the prior art because the prior art does not disclose or render obvious the feature, as described in Claim 1, of putting into both the public data record and the private data record an indicator to indicate that both of these data records emanated from a common source, and specifically, the same, given person.

In order to best understand this feature and its significance, it may be helpful to review briefly the present invention and the prior art.

The present invention, generally, relates to procedures for allowing a viewer of a public data set to have use access, but not read access, to a related record in a private data set. In a preferred embodiment of the invention, a data record from a given person is separated into a public data record and a private data record. A logical link is created to provide access to the private data record from the public data record, and this access enables use of the private data record without providing read access to that private record. As part of creating this logical link, an indicator is put into the public data record and the private data record to indicate that both of these records emanated from a common source, which is that given person.

In the operation of the invention, a request is received from a user, such as a merchant, to perform a predefined operation using information from the private data record. This request comprises information from the public data record and the logical link. In response to this request, the private data record is found using the information from the public data record in combination with the logical link. A predefined operation is then performed using the private data record, and this is done without the user having read access to the private data set. This predefined operation may be, for example, sending a targeted advertisement to a person who matches a defined profile.

de l'Etraz describes a system for proving a contact pathway that indicates how to contact certain persons and organizations. This system includes a public information database containing data on the members of a plurality of entities in which a user has an interest in, and a private contact information database containing the personal contacts of the user. Software code is provided for accessing, in response to receiving a request from the user, the public and private databases, and this software code processes accessed information located in the databases in order to display a contact pathway.

There are a number of important differences between the present invention and the procedure disclosed in de l'Etraz is the type of access the user has to the private data. For instance, with the present invention, the logical link, which links the public data record with the private data record, provides the user with use access but not read access to the private database. In contrast, in de l'Etraz, the user not only has read access to the private database, the user is actually the one who provides the data to that private database.

Another important difference between de l'Etraz and the present invention is that, with the present invention, the data in both the private data record and the public data record emanate from a common source – the person for whom the user is searching. In de l'Etraz, the user – not the person for whom the user is searching - provides the private data record.

These features of the present invention because they enable users, such as merchants, to use data from the private database without actually having read access to that data, thus maintaining the confidentiality of that private data. There is no reason to maintain this confidentiality with the procedure disclosed in de l'Etraz because, as indicated above, in de l'Etraz, the user is the one who actually provides the data to the private database. Moreover the

user is ensured that the data in the private record is for the same person that the data in the private record is for.

In order to address the deficiencies of de l'Etraz as a reference, the Examiner cited Ewing for its disclosure of providing access to the private data record from a public data record.

Ewing describes a gift giving system in which persons give gifts to other persons without necessarily knowing the recipients name. In this system, referred to as a blind gift system, a request is received from a first party to take an order for a gift to be sent to second party known only by a pseudonym. Delivery of the gift can then be effected without the giver knowing the true name of that second party. As part of this process, entry of the giftee's pseudonym into a database initiates a search function; and as a result of this search, the full true name and mailing address information associated with the pseudonym is identified.

One important difference between the present invention and the procedure disclosed in Ewing is that, in the present invention, the data in the public record and the data in the private record come from the same source. Moreover, both of these records are provided with an indicator to indicate that the two records emanated from a common source.

The other references of record have been reviewed and these other references, whether considered individually or in combination, also do not disclose or suggest this feature of the present invention.

Scroggie, et al. was cited for its disclosure of using certain information including a network address, and transmitting a message to that address. This reference does not disclose or suggest, though, accessing and using private data, in the manner described above, without giving the user/requestor read access to the private database.

Independent Claim 1, which is a method claim directed to a method for accessing data records in a private data set, is being amended to describe the above-discussed feature of this invention. Specifically, Claim 1 is being amended to add the limitation that the step of creating a logical link to provide access to the private data record from the public data record includes the step of putting into the public data record and the private data record an indicator to indicate that both the private data record and the public data record emanated from the same given person.

In view of the above-discussed differences between Claim 1 and the prior art, and because of the advantages associated with those differences, claim 1 patentably distinguish over the prior art. Claims 2-15 are dependent from, and are allowable with, Claim 1. The Examiner is, accordingly, respectfully asked to reconsider and to withdraw the rejections of Claims 1-15 under 35 U.S.C. 103, and to allow these claims.

Every effort has been made to place this application in condition for allowance, a notice of which is requested. If the Examiner believes that a telephone conference with Applicants' Attorneys would be advantageous to the disposition of this case, the Examiner is asked to telephone the undersigned.

Respectfully submitted,

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